

Appl. No. 09/441,142  
Amdt. dated July 5, 2005  
Reply to Office Action of March 3, 2005

PATENT

**REMARKS/ARGUMENTS**

This Amendment is responsive to the Office Action mailed on March 3, 2005. A petition for a one month extension of time is attached, and since July 3, 2005 falls on a Sunday and since July 4, 2005 is a holiday, the due date is extended to July 5, 2005.

In this Amendment, non-elected claims 106 and 109 are canceled, claim 96 is amended to incorporate the limitation in claim 106, and new claims 110-112 are added.

In the Office Action, claims 96-98 and 107 are rejected as anticipated by Singer et al. Claims 96-98, 100, and 107 are rejected as being obvious over UK '856 and Singer et al. Claims 96, 98, 100, and 107 are rejected as obvious over Derman and Singer et al.

These rejections are traversed. However, the limitation in dependent claim 106 is incorporated into the independent claim 96. Claim 106 was not rejected over Singer et al., UK '856, or Derman, so that withdrawal of the above rejections is requested.

The only remaining rejection of record pertinent to amended independent claim 96 is the rejection of claims 106 and 109 over Wilson at page 4 of the Office Action.

**I. Wilson does not render the claims *prima facie* obvious**

Wilson fails to render claim 96 (and also new independent claim 110) obvious for a number of reasons. Wilson discloses an "object 14" in FIGS. 1 and 2, and a "connector 20" that appears to pass through a hole in the object 14. As shown in FIG. 1 of Wilson, the connector 20 has a circular cross-section and is threaded. The hole in the object 14 would also be circular in shape, or else the threaded connector 20 could not engage it.

**A. Obviousness has not been established, since Wilson does not teach or suggest all claim limitations in independent claims 96 and 110**

Obviousness has not been established, since all limitations are not taught or suggested by the Wilson. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP 2143.03. Here, it is clear that Wilson does not teach or suggest both a "slot engagement member" and an "inhibiting member". The Examiner might believe that

Appl. No. 09/441,142  
Amdt. dated July 5, 2005  
Reply to Office Action of March 3, 2005

PATENT

the "slot engagement member" is Wilson's threaded connector 20 which is inserted into a hole in an object 14. If this is the "slot engagement member", then there is no "inhibiting member", since only one structure, the connector 20, fits into the hole in the object 14. Conversely, if the connector 20 is an "inhibiting member", then there is no "slot engagement member" in Wilson, since there is only one structure that fits into the hole in the object 14. Accordingly, all limitations are not taught or suggested by Wilson and the rejection should be withdrawn for this reason alone.

There is also no motivation to use a slot engagement member in conjunction with an inhibiting member in Wilson. As noted above, a single connector 20 screws into a hole into an object 14 in Wilson and this appears to be satisfactory. One would not have added an additional slot engagement member or inhibiting member to Wilson, since there would be no need to do it, and since it would make Wilson's device more complex.

The Office Action does not identify which teaching in Wilson constitutes a retractable "inhibiting member" and which teaching in Wilson constitutes a "slot engagement member." According to the Examiner:

Claims 106 and 109 are rejected under 37 U.S.C. 103(a) as being unpatentable over Wilson (232). It would have been obvious to utilize the claimed slot dimensions, since it has been held that discovering an optimum value result effective variable involves only routine skill in the art. [citation omitted].

Should the rejection based on Wilson be maintained, the Examiner is requested to identify the features in Wilson that constitute the "inhibiting member" and "slot engagement member".

B. *Wilson teaches away from a security slot having dimensions of about 3 mm by about 7 mm*

Wilson also does not teach or suggest a system comprising, *inter alia*, a portable electronic device including a security slot having dimensions of about 3 mm by about 7 mm as recited in independent claims 96 and 110. An example of such a slot is shown at FIG. 8 of the present application. The Office Action recognizes that Wilson does not teach a security slot

Appl. No. 09/441,142  
Amdt. dated July 5, 2005  
Reply to Office Action of March 3, 2005

PATENT

having dimensions of about 3 mm by about 7 mm, but alleges that it would have been obvious to have modified Wilson to include it.

Obviousness has not been established, since there is no motivation to modify the prior art to arrive at the inventions of claims 96 and 110. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). Here, there is no motivation to modify Wilson in the manner proposed by the Examiner.

One skilled in the art would not have been motivated to have modified the circular hole in Wilson's object 14 to be a security slot having dimensions of about 3 mm by about 7 mm, because this would make Wilson's device unusable. If a proposed modification would render a prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984). MPEP 2143.01. As noted above, the connector 20 in FIG. 2 of Wilson is circular, and the corresponding hole in the object 14 is also circular. As noted at column 2, lines 34-35 of Wilson, the "connector 20 [is] *screwed into* the object 14".

In comparison, a security slot embodiment that has dimensions of about 3 mm by about 7 mm is generally rectangular in shape. If one of ordinary skill in the art were to modify Wilson's circular hole to be a generally rectangular slot having dimensions of about 3 mm by about 7 mm, Wilson's circular connector 20 would be unable to engage the object 14, since the round connector would not be configured to engage the newly formed slot. One could also not "screw" the circular connector 20 into the proposed generally rectangular slot having dimensions of about 3 mm by about 7 mm as required by Wilson. Accordingly, contrary to the Office Action, one would not have been motivated to have modified Wilson's object 14 to include a security slot having dimensions of about 3 mm by about 7 mm, since this would make Wilson's device unsatisfactory for its intended purpose, and would at a minimum make Wilson's device "much less desirable" than the device that is actually disclosed in Wilson. Accordingly, there is no motivation to modify Wilson to arrive at the invention of independent claims 96 and 110 and obviousness has not been established.

Appl. No. 09/441,142  
Amdt. dated July 5, 2005  
Reply to Office Action of March 3, 2005

PATENT

C. *One would not have changed Wilsons' round hole to a slot that has dimensions of about 3 mm by about 7 mm to "optimize" it*

According to the Examiner, one skilled in the art would have "optimized" the hole in Wilson to have dimensions of about 3 mm by about 7 mm. The Examiner relies on *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) in support of the "optimization" rationale. However, MPEP 2144.05's description of *Boesch* is as follows:

A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977) ... See also *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) (prior art suggested proportional balancing to achieve desired results in the formation of an alloy). (emphasis added.)

As noted in the MPEP, in *Boesch*, the "prior art" suggested proportional balancing to achieve a desired result. In the present rejection, the alleged prior art, Wilson, does not suggest that Wilson's round hole should be "optimized" to one that has dimensions of about 3 mm by about 7 mm. As explained below, Wilson actually teaches away from the alleged optimization.

One would not "optimize" Wilson's circular hole in his object 14 to make it a security slot having dimensions of about 3 mm by about 7 mm, since doing so would make Wilson's device inoperative. If the Examiner's proposed modification were made to Wilson, then Wilson's round, threaded connector 20 would not be able to engage the generally rectangular hole having dimensions of about 3 mm by about 7 mm. As explained above, this would not only make Wilson's device "less optimal", but would make it inoperative. Accordingly, contrary to the rejection, one would not have "optimized" Wilson to arrive at the claims.

Even assuming, *arguendo*, that the optimization rationale was even viable, Applicants are providing evidence that the claimed security slot having dimensions of about 3 mm by about 7 mm helped solve a long felt need, has been recognized by others, and has advantages. Such evidence would be sufficient to rebut any allegation of obviousness. As explained in the attached Declaration of William Murray Pursuant to 37 C.F.R. § 1.132, which

Appl. No. 09/441,142  
Amdt. dated July 5, 2005  
Reply to Office Action of March 3, 2005

PATENT

was filed in U.S. Patent Application No. 10/839,521, an embodiment of a security slot that has dimensions of about 3 mm by about 7 mm is referred to in the industry as the "Kensington slot". As explained therein, the Kensington slot has been recognized in the computer industry as being an effective security solution and has satisfied a long felt need. Computer theft problems were recognized as early as early as 1976, but until the Kensington slot was invented, numerous other attempts to solve the problem of theft were not widely adopted. Accordingly, to the extent that the Examiner believes that the creation of a security slot having the dimensions of about 3 mm by about 7 mm was some sort of "routine optimization", Applicants submit that it was not "routine" or else others would have thought of it years before Applicants thought of it. The information in the Declaration also rebuts any allegation that the alleged "optimization" is one that is routine and one that is without a beneficial or advantageous result. As indicated in the Declaration, the security slot having dimensions of about 3 mm by about 7 mm has been widely accepted by the computer industry as a standard security solution and has been recognized as such by numerous publications. Accordingly, even assuming, *arguendo*, that obviousness has been established, the evidence in the Declaration is sufficient to overcome any obviousness allegation.

Appl. No. 09/441,142  
Amdt. dated July 5, 2005  
Reply to Office Action of March 3, 2005

PATENT

**CONCLUSION**

As noted above, at least *two* limitations from independent claims 96 and 110 are clearly missing from Wilson, and Wilson teaches away from the modification proposed by the Examiner. Accordingly, there are many more reasons why the claims are patentable, rather than unpatentable. In view of the foregoing, the issuance of a formal Notice of Allowance at an early date is respectfully requested.

Respectfully submitted,



Patrick Jewik  
Reg. No. 40,456

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 415-576-0200  
Fax: 415-576-0300  
PRJ  
60529973 y1